



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/793,416	10/23/1997	JOHN THOMAS HARE	18872.0056	5267

7590 12/26/2001
HODGSON RUSS ANDREWS WOODS & GOODYEAR
1800 ONE M & T PLAZA
BUFFALO, NY 14203-2391

EXAMINER

BEHREND, HARVEY E

ART UNIT	PAPER NUMBER
----------	--------------

3641

DATE MAILED: 12/26/2001

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
			11

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 9/26/01 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-19 are pending in the application.

Of the above, claims 9-19 are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-8 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit: 3641

1. Applicants election with traverse in the 9/26/01 response, of Group I, species A (Fig. 1 embodiment) and, silicone resin as the species of outer polymeric material, is acknowledged.

Applicants arguments are unpersuasive. As set forth more fully below, the "special technical feature" set forth for example in claim 1, does not define over the prior art.

The examiner does not agree that claims 1-10 and 12 read on each of the elected species.

Applicant has elected specie A (the embodiment of Fig. 1, which is a one part structure, see specification bottom of page 6).

Claim 9 is directed to the non-elected specie B (embodiment of Fig. 2, specification, top of page 7).

Claim 10 is directed to a plural part structure and reads for example on non-elected specie 5.

Claim 12 is directed to non-elected species which prevent shine, e.g. specie 5.

Accordingly, an action on claims 1-8 follows.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3641

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(a) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any of Sedlak et al, Breton et al or Weinberger.

The references each illustrate structures as claimed. Note that the structures of any of the references can inherently be shaped or molded into any shape desired, including a curved shape, e.g. see col. 12 of Breton et al and page 3 of Weinberger.

Note that this curved shape of any of the references is inherently capable of surrounding a radiation source. To meet the actual claim language, it is only necessary for this capability to be present.

Art Unit: 3641

As to limitations which are considered to be inherent in a reference, note the case law of In re Ludtke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al, 195 USPQ 430, and In re Brown, 173 USPQ 685, 688.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Breton et al or Weinberger.

Note the discussion of the references in section 4 above.

Claim 7 recites a thickness for the core layer of 5 to 50 mm. However, the core layer of either reference can clearly be made of any thickness desired (including in the range 5 to 50 mm) depending on the degree of shielding desired and, to so modify either reference would accordingly have been *prima facie* obvious. Note particularly that such is what is essentially indicated in the sentence bridging pages 3 and 4 of Weinberger.

Additionally, as set forth in MPEP 2144.04 section IV, a mere change in size does not in itself, impart patentability.

6. Claim 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sedlak et al.

Note col. 4.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Breton et al, Sedlak et al, or Weinberger alone or with Harrison, alone or with any of Cote, Fry et al or McClintock.

The primary references have been discussed above. The structures of any of the primary references are made in sheet form and shaped or curved as desired. It is conventionally known in

Art Unit: 3641

the art to utilize radiation shielding for pipes carrying a radiation emitting material and it would have been obvious on its face to so utilize the radiation shielding of any of the primary references. In any event, such would have been obvious in view of the teachings thereof in Harrison. Note that the most obvious manner of wrapping said sheet material around a pipe is to cut it to size such that the cut ends abut each other when the sheet is wrapped around the pipe (thus in effect, providing a longitudinal slit).

In any event, it is a notoriously well known expedient that in forming a shielding type material for around a pipe, to form said shielding type material into a tubular shape with a longitudinal slit to facilitate mounting to the pipe, as evidenced for example by the teachings thereof in any of the secondary references of Cote, Fry et al or McClintock and to so modify any of the primary references would accordingly have been *prima facie* obvious.

8. The other references cited further illustrate pertinent art.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831.

The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Art Unit: 3641

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Behrend/cw
December 6, 2001



**HARVEY E. BEHREND
PRIMARY EXAMINER**